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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,070	12/07/2000	Max Hamberg	4925-98PUS	4634

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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
2683	78

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,070

Applicant(s)

HAMBERG, MAX

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

1. The new drawings transmitted overcome the examiner's objections.
2. The applicant's argument regarding the examiner requesting an Abstract appears to overcome the objection. The examiner was merely attempting to get the application in the "typical" format for printing (should the application become a patent).
3. The applicant has overcome the objection regarding format/headings.
4. The signed IDS provided by the examiner lists the only patents that were reviewed by the examiner. Any ancillary patents in the case are deemed not part of the case as agreed to by the applicant and examiner.
5. The objection to claims 19-20 has been overcome.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Widegren et al. WO97/34437 and further in view of Veloso US 6,122,508 and Malmstrom US 5,901,359 (hereafter Widegren, Veloso and Malmstrom).

As per **claims 1, 13 and 20**, Widegren teaches a method for connecting a system comprising a subscriber apparatus of a user (figure 1, #116, #118, #120, #122) to a host mobile network (figure 1, #104 or #108 being private or public communication systems) comprising:

Storing in a network element connected to the mobile network subscriber data (figure 2 showing HLR and VLR's which store subscriber data)

Emulating towards said host mobile network a first interface of said first interface being of said host mobile network

Emulating towards said subscriber system a second desired interface, said second interface being of said subscriber system

Connecting signals of said subscriber system to the host mobile network and signals of the host mobile to said subscriber system (abstract, figure 1 - WO gateway and page 6, L8-37 to page 7, L1-21 which connects the user to first/second interfaces, ie. private or public wireless systems – the examiner notes that these systems could be interpreted as both being private or both being public and/or both being wired or wireless).

But is silent on use of a SIM card/memory means (eg. information corresponding to information concerning the subscriber apparatus of the user of the subscriber system wherein the network element associated the subscriber of the user with a mobile communication means of the user on the host mobile network AND based on said stored subscriber data AND desired interfaces.

The examiner notes that the use of SIM cards is well known in GSM mobile networks AND **Veloso** teaches a mobile radio system with wireline subscriber terminals with card reading devices (for reading authorization cards (SIM)) that can connect to a wireless system (abstract and figure 1). **Widegren** also teaches that the WO Gateway can store phone numbers and routing data regarding the internal corporate phone network as well as provide internal special services and call features (page 7, L22-36 to page 8, L1-11). Lastly, the HLR/VLR stores data for a user and is involved in a handoff should a user roam from one system to another.

With regard to "desired interfaces", Malmstrom teaches wireline/wireless connectivity for forwarding/routing calls based on the location of the user which involves the use of an HLR (abstract). The ability of this system to forward calls based on the location of the user, in the examiner's opinion, reads on a "desired interface" since the

system will intelligently choose an optimal communications means (eg. as desired by the user).

The examiner also notes (but does not cite), per the enclosed written opinion, that Robert (WO9533348) has teachings which read on the claimed invention (as does Bales and Brunner).

With further regard to claim 13, the examiner interprets the emulation and switching blocks as disclosed in Widegren (figure 1, WO gateway and page 7, L4-21).

It would have been obvious to one skilled in the art at the time of the invention to modify Widegren, such that SIM card data can be stored by the element/gateway and uses desired interface(s), to provide support to any/all phone that use SIM cards and for central storage of SIM data thus enabling the system to choose a system for optimal user communications.

As per **claims 2 and 14**, Widegren teaches claim 1/13 wherein the network element is used to emulate mobile network functions associated with mobile devices that are not realized by the subscriber apparatus in said system (page 7, L4-22 teaches the WO gateway which is hardware/software implementation that provides interface between wired and wireless users and would contain memory/database and Widegren also teaches that *the WO Gateway can store phone numbers and routing data regarding the internal corporate phone network as well as provide internal special services and call features* (page 7, L22-36 to page 8, L1-11).

Widegren also teaches HLR/VLR functionality/databases (figure 2, #210/#212).

As per **claim 3**, Widegren teaches claim 2 **but is silent on** wherein at least part of said functions are functions dependent on said subscriber data.

The examiner notes that the WO Gateway can provide various "internal" call functions (page 8, L3-11) and the subscriber database taught by Widegren can contain virtually any type of data AND **Veloso** teaches a mobile radio system with wireline subscriber terminals with card reading devices (for reading authorization cards (SIM)) that can connect to a wireless system (abstract and figure 1). Widegren also teaches that the WO Gateway can store phone numbers and routing data regarding the internal corporate phone network as well as provide special internal special services and

features (page 7, L22-36 to page 8, L1-11) which can be dependent upon each subscriber's individual call information since different people in the company would have different subscriber profiles (eg. compare the CEO to a manager to a regular worker).

It would have been obvious to one skilled in the art at the time of the invention to modify Widegren, such that part of the functions are dependent upon subscriber information, to provide means for the phone system to provide the correct functions to each individual user based on their profile/subscriber information.

As per **claim 4**, Widegren teaches claim 1 characterized in that the network element is used to receive signals from said subscriber system, which signals are coming from signal lines of which there are a certain first number, and said received signals are connected into signal lines of the mobile network of which there are a certain second number such that the second number is smaller than said first number (figure 1 shows the WO Gateway #124 connected to various systems, such as the RAN, MSC and Int/Ext ACC's – the use or non-use of multiplexing on any of these links would decrease or increase the number of signal lines required between the systems). One skilled in the art would provide multiplexing where convenient and cost effective to carry multiple connections over one physical link (ref. Widegren's reference to ISDN, page 7, L19-21).

As per **claims 5-7 and 16-18**, Widegren teaches claim 1/15 the WO Gateway can be located at various locations (page 7, L10-12) and one skilled in the art would locate the first desired interface between BSC and MSC, between BSC and BTS or between mobile and BTS.

As per **claim 8**, Widegren teaches claim 1 in that at least part of the host mobile subscriber information needed by the network element is read from a database stored in the network element (figure 1, WO Gateway also comprises HLR/VLR functionality/databases, #210/#212).

As per **claim 9**, Widegren teaches claim 1 in that at least part of the host mobile subscriber information needed by the network element is generated automatically (figure 1, WO Gateway also comprises HLR/VLR functionality/databases, #210/#212, which are updated automatically as the mobile user roams. Other functions may be updated by a system administrator should a user's subscriber profile change per page 8, L3-7).

As per **claims 10-12**, Widegren teaches claim 1 and that mobile-to-mobile, fixed-to-fixed, fixed-to-mobile and mobile/fixed (private)-to-fixed/mobile (public) calls can be connected by the subscriber system (abstract and figure 1).

As per **claim 15**, Widegren teaches claim 13 and emulation/output blocks for realizing functionality according to a predetermined interface of said host mobile network (figure 1 shows WO Gateway with input/output connections and emulation, page 7, L4-21).

As per **claim 19**, Widegren teaches claim 13 and that it comprises a database block for storing host mobile network subscription data corresponding to the subscriber apparatus in said subscriber system (*WO Gateway can store phone numbers and routing data regarding the internal corporate phone network as well as provide internal special services and call features*, page 7, L22-36 to page 8, L1-11) as well as provide HLR and VLR functions/databases (figure 2, #210/#212).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

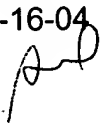
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMD

3-16-04



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